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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,259	12/05/2003	Diane C. Thornton	190250-1780	1176

38823 7590 07/05/2007

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EXAMINER

GEBRESILASSIE, KIBROM K

ART UNIT	PAPER NUMBER
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2128

MAIL DATE	DELIVERY MODE
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07/05/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/729,259

Applicant(s)

THORNTON ET AL.

Examiner

Kibrom K. Gebresilassie

Art Unit

2128

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is responsive to amended application filed on 04/11/2007.
2. Claims 1-27 are pending.
3. Claims 1, 10, and 19 have been amended.

Response to Arguments

4. Response Drawing Objection: Examiner indicated in the previous Office action mailed on 01/12/2007 the drawings must show every feature of the invention specified in the claims such as *receiving logic, a database coupled to the receiving logic, assignment logic coupled to the database, completion logic, and reporting logic*. However, applicants have not response to the objection of the drawings and therefore the objection is maintained until applicant's response the objection [**See: Drawing Objection below**].

5. Response to 101 rejection: Applicant's arguments filed 04/11/2007 have been fully considered but they are not persuasive.

Applicants argued that the "logic" and "database" are not program per se.

Applicants used a dictionary to prove the "logic" and "database" are hardware components as shown below:

Merriam-Webster Dictionary defines logic to be "the arrangement of circuit elements (as in a computer) needed for computation; *a/so*: the circuits themselves." See <http://www.m-w.com/cgi-bin/dictionary?book=Dictionary&va=logic>. Further, a "database" has been defined to be "one component of a database management system." See *Free On-line Dictionary of Computing* at <http://foldoc.org/?database>.

In response, examiner respectfully disagrees. The “logic” and “database” could also define as follows:

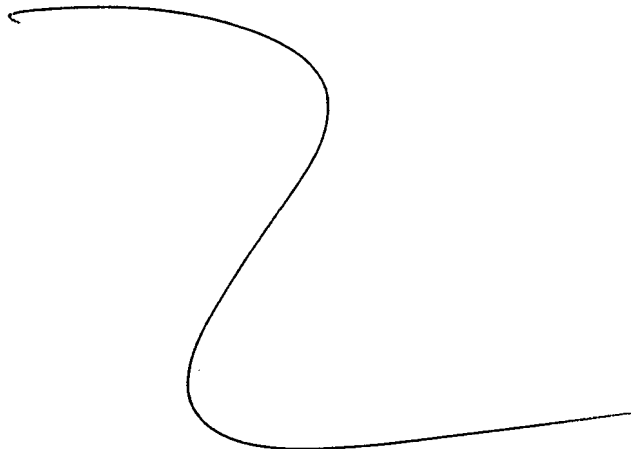
Microsoft Computer Dictionary Fifth Edition defines:

“logic” to be “in programming, the assertion, assumptions, and operations that define what a given program does. Defining the logic of a program is often the first step in developing the program’s source code”, which interpreted as abstract idea.

“Database” to be “a file composed of records, each containing fields together with a set of operations for searching, sorting, recombining, and other functions”, which interpreted as software per se.

Therefore, the definition of “logic” and “database” could have more than one meaning.

Further, in light of specification, it is not clear whether “logic” and “database” are hardware components. Because there is no a clear support or antecedent basis in the description, the claim must be given their broadest reasonable interpretation.

A large, stylized handwritten mark, possibly a 'Z' or a '3', is drawn in the lower half of the page. It starts with a horizontal line at the top, curves down and to the left, then curves back up and to the right, ending with a horizontal line at the bottom.

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6. Response to 102(e) rejection: Applicant's arguments filed 04/11/2007 have been fully considered but they are not persuasive.

a. Applicants argued:

Claim 1 is patentable over *Chauhan* for at least the reason that *Chauhan* fails to teach or suggest "assignment logic coupled to the database, operable to assign the drawing conversion job record to a draftsman and to instruct the database to record the assignment, the drawing conversion job involving creation of a new drawing file based on information depicted in the land base drawing file; and completion logic coupled to the database, operable to receive a request to close the drawing conversion job record from the draftsman, and to instruct the database to mark the drawing conversion job record as closed," as emphasized above and recited in claim 1.

In response the prior art of reference teaches as follows:

party work management system in a step 302. The Utility-Center™10 then assigns a Field Engineer (FE) to the customer site with a laptop and brings up the required work in a step 303. The work information is stored under a Work Order Header. The FE directly interacts with the Utility-Center™10 to draw work order based upon GIS features and sketches retrieved from the GIS 900. New features can be inserted by hand, by constructive geometry, or by GIS location in a step 304. Then the entered information is

(See: [0081])

into a proposed system on the network. After construction is complete the proposed work orders are electronically transferred to the existing plant. All utility personnel have the ability to draw their proposed work such as system improvement, right of way jobs, or other suggested changes into the system. All proposed jobs can be queried or viewed enterprise wide. The uaField™100 prints staking sheets and generates a material order list showing the assembly unit

(See: [0121])

[0122] The uaField™100 easily stakes new construction work orders in the field or office and update that information directly into the GIS 900 to avoid duplicate data entry. Because the GIS 900 is seamless and completely field portable, staking engineers, line crews and others can have access to updated data daily. Engineers have the option of

(See: [0121])

also

[0125] When a work order is finished, it is posted as "pending" in the GIS. This proposed job is viewable by all users throughout the system so every employee is aware of the job and the pending change in the GIS. Proposed jobs are color coded so users can easily identify which facilities are in the current GIS 900 and which are in process of construction.

(See: [0125]).

- b. The same reasoning for argument will apply for claim 10, and 19.
 - c. The same reasoning for argument will apply for dependent claims because no argument was presented.
7. Examiner finds applicants argument unpersuasive and rejection is maintained.

Drawings

8. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the receiving logic, a database coupled to the receiving logic, assignment logic coupled to the database, completion logic coupled to the database, and reporting logic coupled to the database must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate

prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 19-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For example, claim 19 recites, "the program comprising:" the "steps" such as receiving, creating... However, a program cannot comprise "steps". A program can comprise "instruction".

Appropriate correction is required.

Claim Rejections - 35 USC § 101

11. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

12. Claims 1-9 are rejected under 35 U.S.C. 101 because the receiving logic, a database, assignment logic, and completion logic are just program per se. Because the claimed invention of Claim 1 is a system claim, the claimed invention should have associated with physical components in order to be statutory.

MPEP 2106 states as follows:

" computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035. Accordingly, it is important to distinguish claims that define descriptive material per se from claims that define statutory inventions."

13. Claims 19-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

For example, the claimed invention recites a "computer readable medium". In light of the specification (**page 16 lines 2-4**), the "computer readable medium" defines as follows:

execution system, apparatus, or device. The computer readable medium can be, for example but not limited to, an electronic, magnetic, optical, electromagnetic, infrared, or semiconductor system, apparatus, device, or propagation medium. More specific

According to the specification, the "computer readable medium" is not limited to tangible mediums. It also includes non-tangible mediums such as *electromagnetic, infrared, and/or propagation mediums*. Therefore, the "computer readable medium" is not limited to physical articles or objects which constitute a manufacture with in the meaning of 35 USC 101 and enable any functionality of the instructions carried thereby to act as a computer component and realize their functionality. As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate s of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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15. Claims 1-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Publication No. US 2004/0236620 A1 issued to Chauhan et al.

Claim 1

Chauhan discloses a drawing conversion management and assignment system (See: [0121] lines 1-5), comprising:

receiving logic operable to receive notification of completion of a land base drawing file (See: [0081] lines 1-5, [121] lines 5-10);

a database coupled to the receiving logic, operable to create a drawing conversion job record associated with the land base drawing file (See: [0081] lines 2-5, [0121] lines 8-16, [0122] lines 1-6);

assignment logic coupled to the database, operable to assign the drawing conversion job record to a draftsman and to instruct the database to record the assignment (See: [0081] lines 5-17), the drawing conversion job involving creation of a new drawing file based on information depicted in the land base drawing file (See: [0121] lines 5-14, [0122] lines 1-6); and

completion logic coupled to the database, operable to receive a request to close the drawing conversion job record from the draftsman, and to instruct the database to mark the drawing conversion job record as closed (See: [0125]).

Claim 2

Chauhan discloses the system of claim 1, wherein the database is operable to store a plurality of drawing conversion job records (See: [0081] lines 13-14).

Claim 3

Chauhan discloses the system of claim 2, further comprising: reporting logic coupled to the database, operable to enable any of a plurality of users to view the drawing conversion job record (**See: [0081] lines 13-16**).

Claim 4

Chauhan discloses the system of claim 3, wherein the reporting logic is further operable to provide a summary report of a plurality of available drawing conversion job records, assigned drawing conversion job records, and complete drawing conversion job records (**See: [0049]-[0051]**).

Claim 5

Chauhan discloses the system of claim 3, wherein the reporting logic is further operable to enable any of a plurality of users to view a plurality of assigned drawing conversion job records (**See: [0081] lines 26-29**).

Claim 6

Chauhan discloses the system of claim 3, wherein the reporting logic is further operable to enable any of a plurality of users to view a plurality of completed drawing conversion job records (**See: [0125]**).

Claim 7

Chauhan discloses the system of claim 1, wherein the land base drawing file is provided by a regional land administration center (such as *Utility Center*; **See: [0084] lines 1-4**).

Claim 8

Chauhan discloses the system of claim 7, wherein the land base drawing file is in an engineering work order format (**See: Fig. 3B and corresponding texts**).

Claim 9

Chauhan discloses the system of claim 1, wherein the drawing conversion job record includes an availability date (such as ***schedule dates***; **See: [0235]**), wirecenter location information (such as ***map viewing***; **See: [0098]**), a completed date (such as ***jobs from beginning to completion***; **See: [0235]**), a quartile assignment (such as ***...complete daily assignments***; **See: [0119]**), and a fiber units allocation (such as ***facility location***; **See: [0084] lines 20-23**).

Claim 10

Chauhan discloses a method for assigning and managing drawing conversions (**See: [0121] lines 1-5**), comprising the steps of:

receiving notification that a land base drawing file is available, the land base drawing file being associated with a wirecenter (**See: [0081] lines 1-5, [121] lines 5-10**);

creating a drawing conversion job record associated with the land base drawing file (**See: [0081] lines 2-5, [0121] lines 8-16, [0122] lines 1-6**), the drawing conversion job involving creation of a new drawing file based on information depicted in the land base drawing file (**See: [0081] lines 8-13, [0121] lines 5-14**);

storing the drawing conversion job record in a database (**See: [0081] lines 13-14**);

assigning the drawing conversion job record to a draftsman (**See: [0081] lines 24-29**);

recording the assignment of the drawing conversion job record in the database (**See: [0081] lines 24-26**); and

closing the job upon receipt of a close request from the draftsman, by marking the drawing conversion job record as closed in the database (**See: [0125]**).

Claim 12

Chauhan discloses the method of claim 11, further comprising providing a report comprising details for at least the plurality of drawing conversion job records in the database (**See: [0048]**).

Claim 14

Chauhan discloses the method of claim 11, further comprising providing a plurality of unassigned drawing conversion job records to a plurality of users (**See: [0049]**).

Claim 15

Chauhan discloses the method of claim 11, further comprising providing a plurality of completed drawing conversion job records to a plurality of users (**See: [0125]**).

As per claims 11, 13, and 16-27:

The limitations of claims 11, 13, and 16-27 have already been discussed in the rejection of claims 2, 4, 7-10, 12, 14, and 15. The instant claims is/are functionally equivalent to the above rejected claims and is/are therefore rejected under the same rationale.

Conclusion

16. Claims 1-27 are rejected.

17. Examiner's Note: **Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant.**

Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. **It is respectfully requested from the applicant in preparing responses, to fully consider the references in their entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.**

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Communications

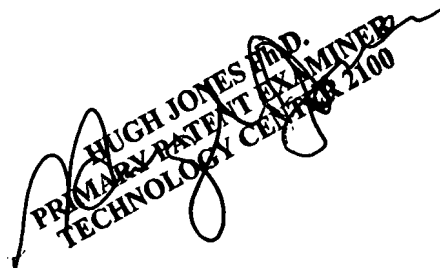
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kibrom K. Gebresilassie whose telephone number is 571-272-8571. The examiner can normally be reached on 8:00 am - 4:30 pm Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamini Shah can be reached on 571-272-2279. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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